

REMARKS

The Examiner rejected claims 13-14 under 35 U.S.C. §112, second paragraph.

The Examiner rejected claims 3-5 under 35 U.S.C. §103(a) as allegedly being unpatentable over Fischer and further in view of Bando et al (US 6,405,244).

The Examiner rejected claims 6-7 under 35 U.S.C. §103(a) as allegedly being unpatentable over the modified Fischer and Bando et al system and further in view of Davis et al (US 5,937,160).

The Examiner rejected claims 8-11 and 13-14 under 35 U.S.C. §103(a) as allegedly being unpatentable over the modified Fischer, Bando et al, and Davis et al system and further in view of MSA (post by Arthur Urbanowicz).

Applicants respectfully traverse the §112 and §103(a) rejections with the following arguments.

35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 13-14 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner argues: "Claims 13-14 recites the limitation "the recipient" in lines 5 and 6 of claims 13 and 14 respectively. There is insufficient antecedent basis for this limitation in the claim."

In response, Applicants have amended claims 13-14 to clarify the invention.

35 U.S.C. §103(a)Claims 3-5

The Examiner rejected claims 3-5 under 35 U.S.C. §103(a) as allegedly being unpatentable over Fischer in view of Bando et al (US 6,405,244).

Applicants respectfully contend that claim 3 is not unpatentable over Fischer in view of Bando, because Fischer and further in view of Bando does not teach or suggest each and every feature of claim 3. For example, Fischer and further in view of Bando does not teach or suggest the feature: "reading from a memory **an authentication key** associated with the originator; including **the authentication key** in an open field of the electronic mail" (emphasis added).

The Examiner argues: "Fischer fails to disclose reading from a memory an authentication key associated with the originator. However, Bando et al teaches reading authentication information associated with the originator (see column 5 line 54 through column 6 line 6)."

In response, Applicants respectfully contend that the Examiner's argument has neglected the fact that "the authentication key" in the "including" step has antecedent basis in "an authentication key" in the "reading" step. In other words, claim 3 requires that the authentication key that is read from memory is the same key that is stored in an open field of the electronic mail, which neither Fischer nor Bando teaches. The Examiner has acknowledged that Fischer does not teach the preceding feature of claim 3. Applicants contend that Bando does not teach the preceding feature of claim 3, because Bando's private key stored in memory is used only to generate a digital signature. Bando does not teach or suggest that the private key is included in an open field of the electronic mail.

Since the Examiner has not demonstrated that the prior art teaches or suggests including

an authentication key read from memory being included in an open field of the electronic mail, the Examiner has not established a *prima facie* case of obviousness in relation to claim 3.

Based on the preceding arguments, Applicants respectfully maintain that claim 3 is not unpatentable over Fischer in view of Bando, and that claim 3 is in condition for allowance. Since claims 4-5 depend from claim 3, Applicants contend that claims 4-5 are likewise in condition for allowance.

In addition with respect to claim 5, Applicants respectfully contend that Fischer and further in view of Bando does not teach or suggest the feature: "wherein the authentication key associated with the originator is further associated with the recipient".

The Examiner argues that Fischer, paragraph 25 teaches the preceding feature of claim 5.

In response, Applicants note that the authentication key disclosed in Fischer, paragraph 25 authenticates the identity of the originator of the electronic mail and does not authenticate the identity of the recipient of the electronic mail. Therefore, the authentication key associated with the originator is not associated with the recipient, and claim 5 is accordingly not obvious over Fischer in view of Bando.

Claims 6-7 and 12

The Examiner rejected claims 6-7 under 35 U.S.C. §103(a) as allegedly being unpatentable over the modified Fischer and Bando et al system and further in view of Davis et al (US 5,937,160).

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Applicants respectfully contend that claim 6 is not unpatentable over the modified Fischer and Bando system and further in view of Davis, because the modified Fischer and Bando system and further in view of Davis does not teach or suggest each and every feature of claim 6. For example, the modified Fischer and Bando system and further in view of Davis does not teach or suggest the feature: "determining whether an authentication key is present in an open field of the electronic mail" (emphasis added).

The Examiner argues: "The modified Fischer and Bando et al system fails to disclose determining whether an authentication key is present in an open field of the electronic mail. Davis et al teaches determining whether a type of information is present in an open field of the electronic mail (see column 11 lines 25-42). At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Davis et al's method of determining the presence of information in the subject field to determine if the authentication information of the modified Fischer and Bando et al system is present. Motivation to do so would have been to allow for different actions to occur based on the information in the subject (see Davis et al column 11 lines 25-42)."

In response, Applicants respectfully contend that the Examiner's argument for modifying Fischer and Bando by the alleged teaching of Davis is not persuasive, because the disclosure by Davis, col. 11, lines 25-42 does not address **an authentic key** with respect to the feature of claim 6 of "determining whether **an authentication key** is present in an open field of the electronic mail" (emphasis added). In other words, Davis does not teach or suggest the preceding feature of claim 6 as alleged by the Examiner. The Examiner's argument that "Davis et al teaches determining whether a type of information is present in an open field of the electronic mail" is

vague and indefinite in relationship to an authentication key. In other words, the Examiner has not established a nexus between a "type of information" and an "authentication key". The Examiner has not cited any prior art reference that teaches or suggests "determining whether an authentication key is present in an open field of the electronic mail".

Based on the preceding arguments, Applicants respectfully maintain that claim 6 is not unpatentable over the modified Fischer and Bando system and further in view of Davis, and that claim 6 is in condition for allowance. Since claim 7 depends from claim 6, Applicants contend that claim 7 is likewise in condition for allowance.

As to claim 12, the Examiner argues: "As per claim 12, the modified Fischer, Bando et al, and Davis et al system discloses claimed material as applied to claims 1 and 6."

In response, Applicants refer to Applicants' arguments *supra* in relation to claims 1 and 6.

In addition, Applicants respectfully contend that claims 1 and 6 do not recite the following feature of claim 12: "rejecting the electronic mail when the authentication key is not associated with the originator". Applicants note that the Examiner has totally ignored the preceding feature of claim 12 and has therefore not established a *prima facie* case of obviousness in relation to claim 12.

Claims 8-11 and 13-14

The Examiner rejected claims 8-11 and 13-14 under 35 U.S.C. §103(a) as allegedly being

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unpatentable over the modified Fischer, Bando et al, and Davis et al system and further in view of MSA (post by Arthur Urbanowicz).

Applicants respectfully contend that claim 8 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, because the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest each and every feature of claim 8. For example, the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest the features: "determining whether an authentication key is expected to be present in an open field of the electronic mail".

The Examiner alleges that page 1, item 1 of MSA discloses the preceding features of claim 8. However, Applicants respectfully contend that the preceding feature of claim 8 does not exist on page 1, item 1 of MSA. In fact, no such conditional determination is disclosed on page 1, item 1 of MSA.

Based on the preceding arguments, Applicants respectfully maintain that claim 8 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, and that claim 8 is in condition for allowance.

Applicants respectfully contend that claim 9 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, because the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest each and every feature of claim 9. For example, the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest the feature: "determining whether an authentication key is expected to be present in an open field of the electronic mail". The Examiner relies on the

Examiner's argument, based on MSA, for the same feature of claim 8. In response, Applicants rely on Applicants' argument *supra* traversing the Examiner's argument that relies on MSA for the same feature of claim 8.

In addition, Applicants respectfully contend that , the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest the feature: "when the authentication key is not present, rejecting the electronic mail; ... and rejecting the electronic mail when the authentication key is not associated with the originator." The Examiner has not even addressed the preceding features of claim 9 and therefore not established a *prima facie* case of obviousness in relation to claim 9.

Based on the preceding arguments, Applicants respectfully maintain that claim 8 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, and that claim 9 is in condition for allowance. Since claims 10-11 depend from claim 9, Applicants contend that claims 10-11 are likewise in condition for allowance.

In addition with respect to claim 10, Applicants respectfully contend that Fischer, Bando, and Davis system and further in view of MSA does not disclose the feature: "reading a memory at an address that is dependent upon a source identifier that identifies the originator".

The Examiner argues: "see MSA where the trusted server name is inherently stored in memory".

In response, Applicants dispute the Examiner's contention that "the trusted server name is inherently stored in memory" is irrelevant, because the feature: "reading a memory at an address that is dependent upon a source identifier that identifies the originator" is not a logical

consequence of the Examiner's allegation that "the trusted server name is inherently stored in memory".

In addition with respect to claim 11, Applicants respectfully contend that Fischer, Bando, and Davis system and further in view of MSA does not disclose the feature: "reading a memory at an address that is dependent upon a source identifier that identifies the originator".

The Examiner argues that the preceding feature of claim 11 is disclosed in Bando, col. 5, line 54 - col. 6, line 6.

In response, Applicants dispute the Examiner's contention that the preceding feature of claim 11 is disclosed in Bando, col. 5, line 54 - col. 6, line 6. Indeed, Bando, col. 5, line 54 - col. 6, line 6 is totally silent as to said "address".

In "Response to Arguments", the Examiner argues: "an address is inherent to memory".

In response, Applicants dispute the Examiner's contention that "an address is inherent to memory" is irrelevant, because the feature: "reading a memory at an address that is dependent upon a source identifier that identifies the originator" is not a logical consequence of the Examiner's allegation that "an address is inherent to memory".

Applicants respectfully contend that claim 13 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, because the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest each and every feature of claim 13. For example, the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest the features: "determining whether an authentication key

is expected to be present in an open field of the electronic mail; when an authentication key is expected to be present, determining whether the authentication key is present; and rejecting the electronic mail when the authentication key is not present in the open field of the electronic mail".

The Examiner relies on the Examiner's arguments relating to claims 12 and 9. In response, Applicants rely on Applicants' arguments relating to claims 12 and 9.

Based on the preceding arguments, Applicants respectfully maintain that claim 13 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, and that claim 13 is in condition for allowance.

Applicants respectfully contend that claim 14 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, because the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest each and every feature of claim 14. For example, the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest the features: "receiving the electronic mail from an originator, the electronic mail having been previously prepared for sending from the originator with a source identifier to the recipient with a destination identifier; determining whether an authentication key is expected to be present in an open field of the electronic mail; when the authentication key is not expected to be present, accepting the electronic mail; when the authentication key is expected to be present, determining whether the authentication key is present; when the authentication key is present, determining whether the authentication key is associated with the originator and further associated with the recipient; accepting the electronic

mail when the authentication key is determined to be associated with the originator and the recipient; rejecting the electronic mail when the authentication key is determined not to be associated with the originator and further associated with the recipient; and when the authentication key is not present, rejecting the electronic mail”.

The Examiner argues: “see rejection of above claims where it is inherent that every email has a source and destination identifier”. In “Response to Arguments” the Examiner further argues that “every email has a source and destination identifier as seen in RFC 822 each electronic mail has source and destination identifiers.”.

In response, Applicants contend that the Examiner has made a statement without providing any analysis to connect the statement with the preceding features of claim 14. Thus, the Examiner’s argument cannot be reasonably understood. Accordingly, the Examiner not established a *prima facie* case of obviousness in relation to claim 14.

Based on the preceding arguments, Applicants respectfully maintain that claim 14 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, and that claim 14 is in condition for allowance.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457.

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